

REMARKS

By the present amendment, independent claim 1 has been amended to further clarify the concepts of the present invention. Specifically, the binder for the coating solution for forming the ink jet recording paper as claimed has been defined as consisting of the recited components of a water-soluble binder and water. Entry of these amendments is respectfully requested.

In the Office Action, claims 1, 2 and 4-6 were rejected under the first paragraph of 35 USC § 112 as not being enabled by the specification as filed. In particular, it now was asserted that the composition "polyvinyl alcohol-cation monomer graft copolymer" was not enabled, since one of ordinary skill in the art would not be able to ascertain what these materials are as they are only identified by tradename.

It was acknowledged that this rejection under the first paragraph of 35 USC § 112 could be overcome by the submission of evidence of the formulation of the tradenamed material at the time of the invention, such as information set forth in sales brochures or product bulletins, which includes sufficient detail about the materials involved. Reconsideration of this rejection in view of the following comments and the enclosed

documents is respectfully requested.

As can be recalled, applicants have already submitted various materials showing that suitable cationic fixing agents are available from Hymo Co., Ltd. of Japan and that these materials provide evidence of the formulation of the tradenamed material at the time of the invention. For convenience of the examiner and to assist in the review of the materials, the materials are resubmitted herein to particularly point out to the examiner how these materials provide evidence of the formulation of the tradenamed material at the time of the invention.

Specifically, attention is directed to (1) Example 22 as set forth on page 46, lines 17-18 of the subject specification uses a composition called SC600-G2 manufactured by Hymo Co. as the cationic polymer fixing agent. This portion of the specification states:

"Cationic polymer fixing agent (SC-600G2 manufactured by Hymo Co., Ltd.)

As described in Table 3 on pages 53-54 of the subject specification, this fixing agent is a "polyvinyl alcohol-cation monomer graft polymer."

Resubmitted herein is (2) the explanation sheet of SC600-G2 written by a staff member of Hymo Co., as well as a translation thereof, along with (3) a safety data sheet for SC600L. It is to be emphasized that these documents demonstrate that SC-600G2 is a graft copolymer of polydimethyldiallyl-ammonium chloride and polyvinyl alcohol, and hence show that a suitable example of the monomer is dimethyldiallylammonium chloride.

Further, resubmitted is (4) the revised version of safety data sheet of HYMACS SC-600L edited on December 8, 1998 (pages 1-3), and partial translation of this version.

In view of the above, it is therefore submitted that one of ordinary skill in the art in this country would be able to obtain these agents without difficulty and practice the subject invention based thereon. For the reasons set forth above, withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1-6 were rejected under 35 USC § 103(a) as being unpatentable over the patent to Koide et al in view of the patent to Yasuda et al and the European patent publication to Koji et al for the reasons of record. As before in making this rejection, it was asserted that the patent to Koide et al teaches a recording paper with a coating composition as set forth in the claim 1 and with the properties as recited in claim 1. Without specifically so stating, it apparently was acknowledged that the disclosed recording paper does not include a cationic fixing agent as defined in claim 1. Then, apparently

reliance was made upon the secondary patent to Yasuda et al for teaches the inclusion of such an agent and also for teaching a cationic polyvinyl alcohol copolymer apparently in reference to the specific subject matter of claim 3. The Koji et al patent publication apparently was relied upon for teaching the additional subject matter of claims 2 and 5. Reconsideration of this rejection in view of the following comments is respectfully requested.

As mentioned above, independent claim 1 has been amended herein to recite that the coating solution consists essentially of the recited components. As such, the claim now recites that the coating solution consists essentially of a diaminostilbene-disulfonic acid derivative (A) as a fluorescent brightening agent, a binder consisting of a water-soluble binder and water, and a polyvinyl alcohol-cation monomer graft polymer (B) as a cationic polymer fixing agent, the mixing ratio A:B in solid coating amount being within the range of 1:6-2:3. It is submitted that the claimed inkjet recording paper as now recited in amended claim 1 is not taught or suggested by the cited patents to Koide et al and Yasuda et al or the European patent publication to Koji et al, whether taken singly or in combination.

In previous responses, it was urged that was that one of ordinary skill in the art would not be motivated to combine the patent teachings in the manner proposed by the examiner. More particularly, it was urged that the portion of the Yasuda et al patent relied

upon (col. 9, lines 36-40) relates to a cationic polymeric substance which functions as a water-proof agent. While it was acknowledged that such may be considered to be basically the same as a cationic fixing agent of the subject invention which does provide water resistance, however one of ordinary skill in the art would not be motivated to use such a substance according to the patent with a water-soluble binder as in the presently claimed ink jet recording sheet. In support thereof, it was stated that the Yasuda et al patent teaches at col. 9, lines 36-39 that the water-proof agent must be water-soluble and further that it is taught that this agent is to be used in conjunction with a water-insoluble binder.

This particular argument was responded to by asserting that the Yasuda et al patent teaches at column 8, lines 38-39 that an water soluble or water insoluble additional binder may be used. Thus, it was asserted that the binder according to the Yasuda et al patent apparently can be a combination of an additional water soluble binder and the primary water insoluble binder. It was submitted that the amendment to claim 1 that the binder consists of a water-soluble binder distinguishes the subject claims over the teachings of the cited patent.

Thus, a major argument made in the previous responses was that claim 1 defines the binder of the ink jet recording material as only having a water-soluble binder by the use of the phrase "consisting essentially of." It was urged that the cited patents do not teach such a binder which is only of a water-soluble binder in order to help distinguish over the

teachings of this patent. However, the present Action alleged that the claims do not limit the binder in this fashion and the use of such a phrase is not persuasive in overcoming the rejection. However, it was indicated that use of the phrase "consisting of" along with the inclusion of water in the solution, would be entered and would overcome the rejection. As mentioned above, the amendments to claim 1 herein now make it clear that coating solution consists essentially of the components as recited and the binder contained in the coating solution consists of a water-soluble binder and water.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 1-2 and 4-6 as amended over the cited patent publications are respectfully requested.

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

Serial Number: 09/673,567
OA dated November 2, 2004
Amdt. dated February 1, 2005

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP



Donald W. Hanson
Attorney for Applicants
Reg. No. 27,133

Atty. Docket No. 001248
Suite 1000, 1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930
DWH/rab



23850

PATENT TRADEMARK OFFICE

Enclosures: Materials as indicated